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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,246	10/15/2002	Ferenc T Fekete	3716/138	3208

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EXAMINER

CEGIELNIK, URSZULA M

ART UNIT	PAPER NUMBER
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3712

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DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/089,246

Applicant(s)

FEKETE ET AL.

Examiner

Urszula M Cegielnik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5-7, 9, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Burrows.

Burrows discloses the method steps of providing a substrate (10); printing a graphic image on the substrate (10); and printing ferromagnetic ink over the substrate to form a guide path for the magnetically guided toy to follow (col. 8, lines 46-67 through col. 9, lines 1-13) as claimed in claim 1; the guide path is

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printed using silk screening techniques (col. 3, lines 46-54) as recited in claim 2; applying a protective layer over the guide path (col. 5, lines 10-25) as recited in claim 3; printing a story on the substrate (col. 4, lines 66-67 through col. 5, lines 1-3), and binding the substrate in a book (col. 3, lines 12-14) as claimed in claim 5; affixing the substrate to a rigid support (col. 3, lines 4-6 and 9-11) as recited in claim 6; the method steps of providing a substrate (10); printing a graphic image on a first side of the substrate (10); silk screening a ferromagnetic ink (col. 3, lines 46-54) on a second side (14) of the substrate to form a guide path for the magnetically guided toy to follow; and applying a clear protective layer (26) over the second side (14) of the substrate (10) as claimed in claim 7; providing a substrate (10); printing a graphic image as a first side of the substrate; silk screening a ferromagnetic ink on a second side of the substrate (col. 3, lines 46-54 and col. 4, lines 29-31) to form a guide path for the magnetically guided toy (col. 8, lines 46-67 through col. 9, lines 1-13) and adhering an opaque sheet over the guide path and to the second side of the substrate (col. 4, lines 29-31, and 57-63) as recited in claim 9; the substrate is paper (col. 3, lines 4-6) as claimed in claim 11, and the opaque sheet is paper (col. 3, lines 4-6 and col. 5, lines 14-15) as claimed in claim 12.

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by United Kingdom Publication No. GB 876054, hereinafter UK '054.

UK '054 discloses a magnetically guided traveling toy comprising a body (19); two motor (24) driven wheels (20) at a back end of the body; and a magnetically guided wheel assembly (22) at a front end of the body (19); the

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wheel assembly including a magnet/wheel holder (27) pivotably coupled to the body (19), a forward projecting arm (26), a magnet (28) disposed to the underside of the arm (26) at a distal end, and one wheel (22) with an axis of rotation perpendicular to, and intersecting with the pivot axis of the holder (27).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows in view of Mitchell.

Burrows discloses the claimed invention except for the protective layer being polypropylene film.

Mitchell discloses a display structure having an outer cover (30) which may be made of polypropylene (col. 4, lines 4-5 and 10-16).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the protective layer as being polypropylene film as taught by Mitchell, since such a modification would provide added protection to the display.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows in view of Eppley.

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Burrows discloses the claimed invention except for applying a UV protective coating over the graphic image.

Eppley discloses a printing process for an eye article for taxidermy. The eye member is coated with a UV coating after coloring (col. 3, lines 20-24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a UV protective coating over the graphic image as taught by Eppley, since such a modification would prevent the graphic image from fading.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over United Kingdom Publication No. GB 876054, hereinafter UK '054 in view of Lee.

UK '054 discloses the claimed invention except for a front wheel self-centering mechanism.

Lee teaches a toy vehicle having a self-centering mechanism (120).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a self-centering mechanism as taught by Lee, since such a modification would allow the toy vehicle to be remotely steered.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 703-306-5806. The examiner can normally be reached on Monday through Friday, from 6:45AM - 3:15PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at 703-306-5648.

Urszula M. Cegielnik  
Assistant Examiner  
Art Unit 3712

A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal line extending to the right.

**DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700**